



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Erik R. Thoen et al. Art Unit : 2881
 Serial No. : 09/542,061 Examiner : J. Menefee
 Filed : April 3, 2000
 Title : SEMICONDUCTOR ELEMENTS FOR STABILIZING LASER OUTPUT

Commissioner for Patents
 Washington, D.C. 20231

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AFFIDAVIT OF DAVID A. SIMONS UNDER 37 C.F.R. § 1.131

I, David A. Simons, declare as follows:

1. I am an associate at Fish & Richardson P.C., and I am the attorney of record for this patent application. My supervisor for this case, Eric L. Prahl, is a principal of Fish & Richardson P.C.

2. I have read the Office Action mailed June 6, 2001, and the article Jiang et al., Nonlinearly Limited Saturable-Absorber Mode Locking of an Erbium Fiber Laser, Optics Letters, 24,15:1074-76 ("the Jiang article"), cited by the Examiner in the Office Action. The Jiang article was published on August 1, 1999.

3. From before August 1, 1999, until the filing date of the application, April 3, 2000, the applicants, the assignee (MIT), and MIT's attorneys exercised due diligence in preparing and filing this patent application.

a) On July 24, 1999, inventors completed a preliminary draft of their invention disclosure. (Thoen Declaration, ¶ 6(a).)

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

10-4-01

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b) By August 17, 1999, the inventors completed their invention disclosure, and submitted it to MIT's Technology and Licensing Office. (Thoen Decl., ¶ 6(b).)

c) On October 22, 1999, the MIT Technology Licensing Office sent a letter to Eric L. Prahl, my supervisor at Fish & Richardson, along with a cover letter. The cover letter instructed our firm to meet with the inventors and begin preparing claims for a patent application.

i) I spoke with Frank D. Cassidy, a Technology Licensing Officer at MIT, about MIT's procedures for processing invention disclosures. Mr. Cassidy informs me that the MIT Technology Licensing Office receives about 9-10 disclosures per week. The Office typically takes 2-3 months to process a disclosure, determine whether to pursue a patent, and assign the case to outside counsel. (If a potential barring event, such as a publication, is imminent, then the case is put on a fast track and processed more quickly.) This case, therefore, was processed within normal time parameters.

d) On October 25, 1999, my supervisor, Eric L. Prahl, received the instruction letter and disclosure from MIT's Technology Licensing Office, and assigned the case to me.

e) On November 8, 1999, I contacted one of the inventors (Professor Ippen), and was then placed in contact with Erik Thoen. Mr. Thoen then sent me prior art and other materials to review.

f) On November 19, 1999, Mr. Thoen, Ms. Koontz (another inventor) and I met at my office to discuss the application and the prior art.

g) Between November 22 and late January 2000, I worked on preparing a draft patent application. While preparing the application, I communicated with Mr. Thoen by telephone and email to ask questions and solicit additional information.

i) In late 1999/early 2000, it was my practice to work on a number of matters simultaneously. Unless a barring event (such as a pending publication) was imminent, I typically would complete a draft patent application 1-3 months after meeting with inventors. In this

case, therefore, I completed my draft within normal time parameters.

- ii) I also recall taking a vacation from late December through early January.
- h) On January 31, 2000, I sent a completed draft application to Mr. Thoen for comments.
- i) On February 14, 2000, I received comments from Mr. Thoen.
- j) On March 2, 2000, I sent a revised draft to Mr. Thoen.
- k) On March 3, 2000, I received additional comments from Mr. Thoen.
- l) On March 7, 2000, I sent a further revised draft to all six inventors.
- m) On March 15, 2000, I received combined comments from all the inventors.
- n) On March 20, 2000, I sent a final draft to each of the six inventors (located in the U.S. and Germany), along with declarations for signature.
- n) After receiving the signed declarations, I caused the patent application to be filed on April 3, 2000.

4. I affirm, under penalty of perjury, that all statements made herein are true, to the best of my knowledge, information and belief.

Dated: 10/4/01

David A. Simons

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